

REMARKS/ARGUMENTS

Claim Amendments

Applicant has amended claims 1-3, 33-43, 47-50 and 52 to delete “sequence motif” and part-sequence motif” in favor of “sequence.”

Applicant has amended claims 3, 34-37, 39-46 and 48-60 to insert a comma (,) before, for example, the terms “further” and/or “wherein.”

Applicant has amended claims 1, 38 and 47 to recite “a functional equivalent thereof which is at least 95% homologous to human PARP2 (SEQ ID NO: 2).” Support for the amendment can be found at least in the original claims and pages 18-20 of the original specification, which describes functional equivalents having at least 85% homology with PARP2 (SEQ ID NO:2). Applicant respectfully submits one having skill in the art would have considered the current claimed range (of at least 95%) to have been inherently described by the description of “at least 60%, preferably at least 75% ... very particularly preferably at least 85%, homology with the starting sequence.” (See page 19 of the original specification; See also, *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) (the ranges described in the original specification included a range of “25%- 60%” and specific examples of “36%” and “50%.” A corresponding new claim limitation to “at least 35%” did not meet the description requirement because the phrase “at least” had no upper limit and caused the claim to read literally on embodiments outside the “25% to 60%” range, however a limitation to “between 35% and 60%” did meet the description requirement. (Emphasis added)).

No new matter has been entered and no new issues, which would require further search and consideration, have been raised. Entry and consideration thereof after final is respectfully requested as the amendments place the application in condition for allowance, in better format for Appeal and/or further limit issues which may be raised on Appeal.

Applicant further submits that several of the amendments address issues raised only for the first time in the Office action of May 22, 2008. Accordingly, Applicant could not have made the requisite claim amendments obviating such issues at an earlier stage in the proceedings.

Accordingly, entry of the instant claim amendments is courteously requested.

Claim Objections

Claims 34-37, 39-46 and 48-60 were objected to for omitting a comma (,) after the term “further.” Applicant has amended such claims, and other claims, to include the omitted comma.

Rejections under 35 USC §112, second paragraph

Claims 34-37, 39-43 and 52 stand rejected as allegedly indefinite. More specifically the Office action asserted that the recitation “part-sequence motif” was unclear. While not agreeing with the grounds of the rejection (Applicant respectfully submits that an ordinarily skilled artisan would be sufficiently apprised of the meaning of “part-sequence motif”), for purposes of advancing prosecution, Applicant has amended the above-identified claims and several others to replace the terms/phrases “sequence motif” and “part-sequence motif” in favor of “sequence,” thereby obviating the rejection.

Applicant has also amended claim 44 to include a missing “E” in the recitation “GX₃LXEVALG,” thereby obviating the rejection.

Withdrawal of the rejections is respectfully requested.

Rejections under 35 USC §112, first paragraph

Claims 1-3 and 33-60 stand rejected as allegedly not being reasonably enabled for “any poly(ADP-ribose) polymerase (PARP) homolog and functional equivalents thereof which is at least 85% homologous thereto.” The Office Action further indicated that “applicant’s reference to ‘at least 85% homologous thereto’ is not necessarily limited to an amino acid sequence homology and may be interpreted as ‘functional homology’, and issue which does not help applicants meet the requirements of 112 first paragraph.”

Applicant has amended each of independent claims 1, 38 and 47 to recite “a functional equivalent thereof which is at least 95% homologous to human PARP2 (SEQ ID NO: 2).” Applicant respectfully submits that the instant specification, coupled with that knowledge generally available to an ordinary skilled artisan at the time the invention was made, sufficiently enables an ordinarily skilled artisan to make and use the invention without undue

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experimentation.

In view of the above, the rejection should be withdrawn.

Conclusion

Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested. Please charge any shortage in fees due in connection with the filing of this paper to Deposit Account 14.1437. Please credit any excess fees to such account.

Respectfully submitted,
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